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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,714	12/20/2000	Per Johan Anders Nystrom	34646-00309USC1	9634

7590 10/10/2003

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EXAMINER

BURD, KEVIN MICHAEL

ART UNIT	PAPER NUMBER
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2631

DATE MAILED: 10/10/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,714

Applicant(s)

NYSTROM ET AL. 

Examiner

Kevin M Burd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23 and 25-47 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. This office action, in response to the amendment filed 7/28/2003, is a non-final office action.

Response to Arguments

2. Applicant's arguments with respect to claims 21-32 have been considered but are moot in view of the new ground(s) of rejection.
3. The previous claim objection is withdrawn in view of the amendment.
4. The previous rejections of the claims under 112, first paragraph are withdrawn in view of the amendment.

Claim Objections

5. Claim 34 is objected to because of the following informalities: the term "ode" appears in line 2 of the claim. It is believed this term should be "code". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 21-23 and 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Willars et al (US 5,831,978).

Regarding claim 21 and 27, Willars discloses a wideband CDMA transmission system (column 2, lines 20-33). This system will comprise mobile units and base stations. Each slot of the transmission (column 4, lines 29-35) comprises a primary code and a secondary code to ensure transmitted data will be properly identified and synchronized with the appropriate mobile station (column 4, line 59 to column 5 line 9). The secondary code will comprise a plurality of bits, wherein the term "Nssc_seq" equals $e^{(\text{bits of information})}$. For transmission from the mobile, all information is modulated by a "valid" modulating sequence.

Regarding claim 22, the primary and secondary codes are transmitted at the same time in the same transmission.

Regarding claim 23, the transmission can be transmitted by any "valid" modulating sequence.

Regarding claim 25, the secondary code identifies the mobile station the transmission is intended for and will be the same in each slot for that transmission.

Regarding claim 26, the communication system is a wideband CDMA system (column 2, lines 20-33).

Regarding claim 28, the secondary code identifies the mobile station the transmission is intended for and will be the same in each slot for that transmission.

Regarding claims 29 and 30, the secondary synchronization code in WCDMA identifies the mobile station.

Regarding claim 31, Willars discloses the secondary code is valid and determines the frame timing (column 4, lines 19-36).

Regarding claim 32, any sixteen bit sequence can have 65,536 different values.

Allowable Subject Matter

7. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 36-40 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 4, 7, 5 and 6 respectively of prior U.S. Patent No. 6,185,244. This is a double patenting rejection.

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10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 33-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 17-19 of U.S. Patent No. 6,185,244. Although the conflicting claims are not identical, they are not patentably distinct from each other because though the claims do not state each of the plurality of code words include a plurality of symbols taken from a set of short codes, it is implied from the claim language. In addition, the reference discloses the additional limitation of "said base station transmitting said generated identification code set formed by concatenating an inner and outer code." It would have been obvious for one of ordinary skill in the art at the time of the invention to omit this step to reduce the complexity of the communication system.

Claim 33 is rejected by the reference's claim 1.

Claim 34 is rejected by the reference's claim 2.

Claim 35 is rejected by the reference's claim 3.

Claim 36 is rejected by the reference's claim 1.

Claim 37 is rejected by the reference's claim 4.
Claim 38 is rejected by the reference's claim 7.
Claim 39 is rejected by the reference's claim 5.
Claim 40 is rejected by the reference's claim 6.
Claim 41 is rejected by the reference's claims 2 and 5.
Claim 42 is rejected by the reference's claim 17.
Claim 43 is rejected by the reference's claim 18.
Claim 44 is rejected by the reference's claim 19.
Claim 45 is rejected by the reference's claim 17.
Claim 46 is rejected by the reference's claim 18.
Claim 47 is rejected by the reference's claim 19.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry or
for informal or draft communications, please label "PROPOSED" or
"DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Kevin Burd, whose telephone number is (703) 308-
7034. The Examiner can normally be reached on Monday-Thursday from 9:00 AM -
6:00 PM.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.



Kevin M. Burd
PATENT EXAMINER
10/9/03